

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 10-01579 CRB	DATE FILED 4/14/10	U.S. DISTRICT COURT 450 Golden Gate Avenue, 16 th Floor, San Francisco, CA 94102
PLAINTIFF TOP VICTORY ELECTRONICS ET AL		DEFENDANT HITACHI LTD. ET AL

PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		See copy of complaint sent previously
2		<i>See attached pg 1</i>
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY	<input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT See attached copy of Order by Judge Charles R. Breyer
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CLERK Richard W. Wicking	(BY) DEPUTY CLERK Maria Loo	DATE November 17, 2010
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Accordingly, standing is not proper and the Court does not have subject matter jurisdiction. The Motion to Dismiss is thus GRANTED. The Motions to Enjoin and to Amend the Complaint are both DENIED.

I. BACKGROUND

Hitachi assigned the patents at issue pursuant to a "Demerger Plan"¹ signed May 26, 2009. Demerger Agreement Translation (Doc. 33-9). The Demerger Plan became effective July 1, 2009, effectively transferring Hitachi's Consumer Business Group and assigning the patents at issue to Hitachi Consumer Electronics (HCE). Hitachi filed a translated copy of the Demerger Plan and a copy in the original Japanese as Exhibits to the Defendants' Opposition to the Motion to Enjoin, filed August 20, 2010. See Demerger Agreement Translation (Doc. 33-9); Demerger Agreement (Doc. 33-7). One of the patents is also owned in part by another Hitachi subsidiary, Hitachi Advanced Digital (HAD). See Mot. to Dismiss (Doc. 19) at 4. Importantly, neither of the subsidiaries to whom the patents are assigned, HCE and HAD, are defendants in this case.

Plaintiff filed this action on April 14, 2010, nearly a year after the Demerger Plan became effective. Plaintiff had reason to believe that Defendants owned the patents at issue, as a result of communications from representatives of Hitachi and Inpro regarding Plaintiff's use of the patents. Opp. to Mot. to Dismiss (Doc. 35) at 6; Chen. Decl. (Doc. 39), ¶ 3, Ex. 2. However, these potential misrepresentations are not material to legal ownership of the patents; ownership and assignment of patents is controlled by written agreements between assignor and assignee. See 35 U.S.C. § 261 (2006) (patent ownership may only be conveyed by written assignment).

Plaintiff cites Hitachi's notices of assignment, filed with the U.S. Patent and Trademark Office (USPTO) on May 25, 2010, as evidence that Hitachi was the owner of the patents at the time the action was filed. Opp. to Mot. to Dismiss (Doc. 35) at 5. The documents Hitachi filed with the USPTO state that Hitachi "is the owner" and that the

¹ The "Demerger Plan" refers to the legal agreement, executed under Japanese law, under which Hitachi spun-off its Consumer Business Group.

1 assignment of the patents "has been transferred." Notices of Assignment (Docs. 36-12, 36-
 2 13, 36-14). Hitachi concedes that the notices read as if Hitachi were still the owner as of
 3 May 25, 2010. See Second Decl. Yokoo (Doc. 50-1) ¶¶ 7-8 (indicating that Hitachi intends
 4 to amend the notices to clarify that the assignment became effective July 1, 2009). However,
 5 filing notice with the USPTO is not required for assignment to be effective, nor does it speak
 6 to the validity of the underlying assignment. See 35 U.S.C. § 261; 37 § C.F.R. 3.54 (2010);
 7 Manual of Patent Examining Procedure (MPEP) (8th ed. Rev. 8, Jul. 2010) §§ 301, 317.03.
 8 The underlying contract assigning the patents is the critical document. See 35 U.S.C. § 261.
 9 Plaintiff's characterization of Hitachi as the actual owner of the patents thus fails.²

10 Hitachi subsidiaries HCE and HAD filed suit against TPV and Vizio, another
 11 television manufacturer, on July 22, 2010 (three months after this action commenced) in the
 12 Eastern District of Texas.³ Hitachi Consumer Elecs. Co., Ltd. and Hitachi Advanced Digital
 13 Inc. v. Top Victory Elecs. Co., et al., Civil Case No. 2:10-cv-260 (E.D. Tex.). On August 6,
 14 2010, Defendant filed this Motion to Dismiss. Mot. to Dismiss (Doc. 19). Plaintiff also
 15 moved this Court to enjoin the Texas action on August 6, 2010 and moved for leave to
 16 amend on August 20, 2010 to add HCE and HAD as defendants. Mot. to Enjoin (Doc. 23);
 17 Mot. for Leave to Amend (Doc. 40).

18 II. DISCUSSION

19 A. Standing in Patent Matters under the Declaratory Judgment Act

20 Article III standing, requiring an actual case or controversy between parties, is
 21 necessary for a federal court to exercise jurisdiction over a matter. See U.S. Const. art. III, §
 22 2; Lujan v. Defenders of Wildlife, 504 U.S. 555, 559 (1992). A matter must be dismissed if
 23 standing is not proper at the commencement of the suit. Schreiber Foods, Inc. v. Beatrice

24
 25 ² Plaintiff does not argue that Inpro, the other Defendant, owns the patent at issue. See Opp.
 26 to Mot. to Dismiss (Doc. 35) at 1-2.

27 ³ Defendants note that there is a third suit involving TPV and related patents pending in the
 28 Eastern District of Texas, filed before this suit. Mot. to Dismiss (Doc. 19) at 2-3 (discussing Mondis
Tech. Ltd. v. Top Victory Elecs. Co., et al., Civil Case No. 2:08-cv-478 (E.D. Tex., filed Dec. 23,
 2008)). As that suit does not presently involve the patents at issue here, and Hitachi, HCE, and HAD
 are not parties to that action, it is immaterial.

Cheese, Inc., 402 F.3d 1198, 1203 (Fed. Cir. 2005). Standing is proper under the Declaratory Judgment Act, 28 U.S.C. § 2201 (2006), only if the court otherwise has jurisdiction. Prasco, LLC v. Medicis Pharm. Corp., 537 F.3d 1329, 1335 (Fed. Cir. 2008); see also Skelly Oil Co. v. Phillips Petroleum Co., 339 U.S. 667, 671-72 (the Act does not provide an independent basis for subject matter jurisdiction). For declaratory actions, the proper test is “whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between the parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 127 (2007) (quoting Maryland Cas. Co. v. Pac. Coal & Oil Co., 312 U.S. 270, 273 (1941)).

In order for a plaintiff to have standing in a declaratory action involving allegations of patent infringement, the defendant must have a legal right in the patent at issue that would allow the defendant to bring suit for infringement. See Fina Research, S.A. v. Baroid Ltd., 141 F.3d 1479, 1481 (Fed. Cir. 1998). Only patentees, assignees, and exclusive licensees have standing to bring a suit for infringement. See 35 U.S.C. § 281 (2006); Sicom Sys. Ltd. v. Agilent Techs., Inc., 427 F.3d 971, 976 (Fed. Cir. 2005). A defect in standing at the time a case is filed “cannot be cured by the addition of a party with standing.” Schreiber Foods, 402 F.3d at 1203. “The declaratory judgment plaintiff bears the burden of proving that there is an actual controversy.” Fina Research, 141 F.3d at 1481.

The Federal Circuit requires⁴ that declaratory actions involving patent infringement allegations meet a two-prong test: “(1) an explicit threat or other action by the patentee, which creates a reasonable apprehension on the part of the declaratory plaintiff that it will face an infringement suit, and (2) present activity which could constitute infringement or concrete steps taken with the intent to conduct such activity.” Fina Research, 141 F.3d at 1481. The Federal Circuit has applied this test to find that standing is not proper in a declaratory judgment action where the defendant is a non-exclusive licensee. See Fina

⁴ The Federal Circuit is binding on district courts in matters of patent law, including jurisdictional matters. See, e.g., Panduit Corp. v. All States Plastic Mfg. Co., 744 F.2d 1564, 1574 (Fed. Cir. 1984) (per curiam); DePuy, Inc. v. Zimmer Holdings, Inc., 384 F. Supp. 2d 1237, 1238 (N.D. Ill. 2005) (applying Federal Circuit precedent on standing in a patent infringement suit).

Research, 141 F.3d at 1481; Enzo APA & Son, Inc. v. Geapag A.G., 134 F.3d 1090, 1093-94 (Fed. Cir. 1998) (dismissing a declaratory judgment claim for failure to join a necessary party, where a non-exclusive licensee defendant, who asserted a counterclaim of infringement, lacked standing). More generally, the Federal Circuit found “no actual controversy between [parties] that would support jurisdiction under the Declaratory Judgment Act,” and thus no standing, where defendants in a declaratory action have “no legal interest [in the patents at issue] and therefore could not bring suit for patent infringement.” Fina Research, 141 F.3d at 1480-81 (summarizing a nonprecedential decision); accord GMP Techs., LLC v. Zicam, LLC, 2009 WL 5064762, at *2 (N.D. Ill. Dec. 9, 2009). This reasoning follows from the test itself, which refers to the “patentee” and threat of an infringement suit, which can only be properly brought by a patent owner, assignee, or exclusive licensee. See Sicom Sys., 427 F.3d at 976; Fina Research, 141 F.3d at 1481. A declaratory judgment action must be dismissed for lack of standing if the plaintiff fails to name the patent owner, assignee, or exclusive licensee, even if the plaintiff was led to believe that the named defendant was in fact the patent owner. See Newmatic Sound Systems, Inc. v. Magnacoustics, Inc., No. C. 10-00129, 2010 WL 1691862, at *4 (N.D. Cal. Apr. 23, 2010).

Accordingly, standing is not proper for legal claims arising under the Patent Act as neither Defendant was an owner, assignee, or exclusive licensee of the patents when the action was filed in April, 2010. As discussed above, Hitachi assigned the patents to its subsidiary HCE effective July 1, 2009. See Demerger Agreement Translation (Doc. 33-9). Further, Hitachi did not retain any ownership interest or an exclusive license upon transfer, nor was ownership transferred to Inpro. Id. Therefore, this Court does not have jurisdiction over requests for relief under the Patent Act.

B. Standing for Equitable Title Holders of a Patent

While the Federal Circuit has been clear that ownership, assignment, or an exclusive license are required for legal remedies, it has indicated that in some circumstances an equitable owner without legal title may pursue equitable remedies. See Arachnid, Inc. v.

1 Merit Indus., Inc., 939 F.2d 1574, 1578-80 (Fed. Cir. 1991) (discussing possibility of a court
 2 having jurisdiction over claims for equitable relief by an equitable title holder of a patent,
 3 emphasizing that an equitable title holder cannot seek damages or other remedies at law
 4 under the Patent Act). The court defined an equitable title as "the beneficial interest of one
 5 person whom equity regards as the real owner, although the legal title is vested in another."
 6 Id. at 1578 n.3.

7 One district court has found that the parent of a patent-holding subsidiary can be an
 8 equitable title holder to the patent, with standing to seek equitable remedies. See Pipe
 9 Liners, Inc. v. Am. Pipe & Plastics, Inc., 893 F. Supp. 704, 706 (S.D. Tex. 1995) (finding
 10 standing was proper where a parent owned a patent-holder subsidiary, where the matter
 11 would proceed regardless of whether the parent were joined as plaintiff).

12 Other district courts have declined to follow this reasoning, however, instead holding
 13 that "a parent [corporation] does not have equitable title in a patent solely by virtue of its
 14 ownership of the subsidiary." Steelcase, Inc. v. Smart Techs., Inc., 336 F. Supp. 2d 714, 719
 15 (W.D. Mich. 2004); accord Beam Laser Sys., Inc. v. Cox Commc'ns, Inc., 117 F. Supp. 2d.
 16 515, 520-21, 520 n.6 (E.D. Va. 2000) (noting that the Federal Circuit has only recognized
 17 equitable title to a patent in a matter involving a contract assigning patent rights to an
 18 invention that had yet to be discovered at the time the contract was formed).

19 That a corporate parent's subsidiary owns a patent is not enough to establish that the
 20 parent has rights in the subsidiary's patents. See Spine Solutions, Inc. v. Medtronic Sofamor
 21 Danek USA, Inc., 620 F.3d 1305, 1317-18 (Fed. Cir. 2010) (holding that where nothing in
 22 the record indicated that the parent was an exclusive licensee of the patent, the court could
 23 not exercise jurisdiction over the parent). And the Federal Circuit has not held that a
 24 corporate parent inherently owns equitable title in a subsidiary's patents. See Beam Laser
 25 Sys., 117 F. Supp. 2d at 520 n.6. Moreover, corporate law sets clear boundaries between
 26 parents and subsidiaries. See Quantum Corp. v. Riverbed Tech., Inc., No. C. 07-04161, 2008
 27 WL 314490, at *1-3 (N.D. Cal. Feb. 4, 2008); Steelcase, 336 F. Supp. 2d at 719; Beam Laser
 28 Sys., 117 F. Supp. 2d at 519-20. This Court has held that even if the companies are closely

operated and the parent purports to act on behalf of the subsidiary, a parent does not have standing in a suit involving patents held by a subsidiary without a showing that boundaries between the corporations have been breached. See Quantum, No. C 07-04161, 2008 WL 314490, at *1-3 (N.D. Cal. Feb. 4, 2008) (parent did not have standing in such circumstances where there was no written assignment and no showing that parent was the alter ego of subsidiary).

Plaintiff's assertion that Hitachi, as the corporate parent of the actual patent-holders HCE and HAD, is an equitable title holder to the patents, is therefore insufficient to establish standing. See Opp. to Mot. to Dismiss (Doc. 35) at 4, 9. Plaintiff only alleges that Hitachi is the equitable title holder because the companies are "closely intertwined by virtue of their parent/subsidiary relationship" and because Hitachi "stands to materially gain, or lose," as a result of this action. Opp. to Mot. to Dismiss (Doc. 35) at 10-11. This does not meet the Plaintiff's burden to establish standing.

III. CONCLUSION

Plaintiff has failed to meet its burden to establish standing, by failing to bring suit against the actual owners of the patents at issue. Standing is not proper now and was not proper when the suit was filed. A lack of standing cannot be cured by adding a party with standing. Schreiber Foods, 402 F.3d at 1203. The Motion to Dismiss is therefore GRANTED, without prejudice. As the Court lacks jurisdiction over this case, the Motions to Enjoin and to Amend the Complaint are both DENIED.

IT IS SO ORDERED.

Dated: November 15, 2010


 CHARLES R. BREYER
 UNITED STATES DISTRICT JUDGE

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RICHARD W. WILKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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9
10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA

12 TOP VICTORY ELECTRONICS
13 (TAIWAN) CO., LTD., a Taiwanese
corporation; TPV
14 INTERNATIONAL (USA), INC., a
California corporation; TPV
15 ELECTRONICS (FUJIAN) CO.,
LTD., a Chinese corporation; TOP
16 VICTORY ELECTRONICS
(FUJIAN) CO., LTD., a Chinese
17 corporation; and ENVISION
PERIPHERALS, INC., a California
18 corporation,

19 Plaintiffs,

20 v.

21 HITACHI, LTD., a Japanese
corporation; INPRO LICENSING
22 S.A.R.L., a Luxembourg S.A.R.L.,

23 Defendants.
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25
26
27
28

Case No. 10 1579

COMPLAINT FOR
DECLARATORY JUDGMENT

CRB

1 Plaintiffs TOP VICTORY ELECTRONICS (TAIWAN) CO., LTD.,
2 TPV INTERNATIONAL (USA), INC., TPV ELECTRONICS (FUJIAN) CO.,
3 LTD., TOP VICTORY ELECTRONICS (FUJIAN) CO., LTD., and ENVISION
4 PERIPHERALS, INC. (collectively, "Plaintiffs"), for their claims for relief herein
5 against defendants HITACHI, LTD. and INPRO LICENSING SARL, aver as
6 follows:

7 **JURISDICTION AND VENUE**

8 1. This is an action for declaratory judgment of non-infringement,
9 invalidity, and unenforceability of eighteen United States patents pursuant to the
10 Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and the patent laws of the
11 United States, 35 U.S.C. § 100 *et seq.*

12 2. In their Claim for Relief, Plaintiffs seek a judicial declaration
13 that Plaintiffs' television products do not infringe United States Patent Nos.
14 5,502,497; 5,534,934; 5,828,417; 6,037,995; 6,057,812; 6,185,228; 6,304,236;
15 6,388,713; 6,549,243; 6,600,870; 6,639,588; 6,686,895; 6,693,966; 7,012,769;
16 7,089,342; 7,286,310; 7,475,180; and 7,475,181 (the "PATENTS-IN-SUIT")
17 and/or that the PATENTS-IN-SUIT are invalid or unenforceable.

18 3. This Court has original jurisdiction over the Claim for Relief
19 under 28 U.S.C. §§ 1331 and 1338(a).

20 4. Venue is proper in this district under 28 U.S.C. §1391(b) and
21 (d). Plaintiffs TPV INTERNATIONAL (USA), INC. and ENVISION
22 PERIPHERALS, INC. are California corporations. Plaintiff ENVISION
23 PERIPHERALS, INC. has its headquarters in Alameda County, California. This
24 action includes patent-based declaratory judgment claims arising from conduct
25 occurring in or directed to Alameda County.

26 **INTRADISTRICT ASSIGNMENT**

27 5. This is an Intellectual Property Action and shall therefore be
28 assigned on a district-wide basis in accordance with Local Rule 3-2(c).

PARTIES

6. Plaintiff TOP VICTORY ELECTRONICS (TAIWAN) CO., LTD. is, and at all times material hereto was, a corporation organized and existing under the laws of Taiwan with its principal place of business in Zhonghe City, Taiwan.

7. Plaintiff TPV INTERNATIONAL (USA), INC. is, and at all times material hereto was, a corporation organized and existing under the laws of the State of California with its principal place of business in Austin, Texas.

8. Plaintiff TPV ELECTRONICS (FUJIAN) CO., LTD. is, and at all times material hereto was, a corporation organized and existing under the laws of the People's Republic of China with its principal place of business in Fuqing City, China.

9. Plaintiff TOP VICTORY ELECTRONICS (FUJIAN) CO., LTD. is, and at all times material hereto was, a corporation organized and existing under the laws of the People's Republic of China with its principal place of business in Fuqing City, China.

10. Plaintiff ENVISION PERIPHERALS, INC. is, and at all times material hereto was, a corporation organized and existing under the laws of the State of California with its principal place of business in Fremont, California.

11. On information and belief, defendant HITACHI, LTD. ("HITACHI") is, and at all times material hereto was, a corporation organized and existing under the laws of Japan.

12. On information and belief, defendant INPRO LICENSING SARL ("INPRO") is, and at all times material hereto was, an SARL organized and existing under the laws of the Luxembourg.

CLAIM FOR RELIEF

13. Plaintiffs repeat and incorporate here the allegations of paragraphs 1 through 12 of this complaint.

1 14. On information and belief, HITACHI claims to be the owner or
2 the exclusive licensee of the eighteen PATENTS-IN-SUIT:

3 U.S. Patent No. 6,057,812, issued May, 2, 2000, and titled
4 "Image Display Apparatus Which Both Receives Video Information And Outputs
5 Information About Itself," a true and correct copy which is attached hereto as
6 **Exhibit A;**

7 U.S. Patent No. 6,304,236, issued October 16, 2001, and titled
8 "Display Apparatus For Adjusting The Display Image Using A Control Signal
9 From An External Computer," a true and correct copy of which is attached hereto
10 as **Exhibit B;**

11 U.S. Patent No. 6,639,588, issued October 28, 2003, and titled
12 "Image Display Apparatus," a true and correct copy of which is attached hereto as
13 **Exhibit C;**

14 U.S. Patent No. 6,686,895, issued February 3, 2004, and titled
15 "Display Unit For Displaying An Image Based On A Video Signal Received From
16 A Personal Computer Which Is Connected To An Input Device," a true and correct
17 copy of which is attached hereto as **Exhibit D;**

18 U.S. Patent No. 7,089,342, issued August 8, 2006, and titled
19 "Method Enabling Display Unit To Bi-Directionally Communicate With Video
20 Source," a true and correct copy of which is attached hereto as **Exhibit E;**

21 U.S. Patent No. 7,475,180, issued January 6, 2009 and titled
22 "Display Unit With Communication Controller And Memory For Storing
23 Identification Number For Identifying Display Unit," a true and correct copy of
24 which is attached hereto as **Exhibit F;** and

25 U.S. Patent No. 7,475,181, issued January 6, 2009 and titled
26 "Display Unit With Processor And Communication Controller Which
27 Communicates Information To The Processor," a true and correct copy of which is
28 attached hereto as **Exhibit G;** and

1 U.S. Patent No. 5,502,497, issued March 26, 1996 and titled
2 "Television Broadcasting Method And System Enabling Picture Broadcasting From
3 The Transmitting Equipment To The Receiving Equipment Using Alternative
4 Broadcasting System Standards," a true and correct copy of which is attached
5 hereto as **Exhibit H**; and

6 U.S. Patent No. 5,534,934, issued July 9, 1996 and titled
7 "Television Receiver Capable Of Enlarging And Compressing Image," a true and
8 correct copy of which is attached hereto as **Exhibit I**; and

9 U.S. Patent No. 5,828,417, issued October 27, 1998 and titled
10 "Television Receiver With On Screen Display For Reserving Programs To Be
11 Recorded Or Viewed," a true and correct copy of which is attached hereto as
12 **Exhibit J**; and

13 U.S. Patent No. 6,037,995, issued March 14, 2000 and titled
14 "Broadcasting And Communication Receiver Apparatus," a true and correct copy
15 of which is attached hereto as **Exhibit K**; and

16 U.S. Patent No. 6,185,228, issued February 6, 2001 and titled
17 "Receiving Apparatus For Digital Broadcasting Signal And
18 Receiving/Recording/Reproducing Apparatus Thereof," a true and correct copy of
19 which is attached hereto as **Exhibit L**; and

20 U.S. Patent No. 6,388,713, issued May 14, 2002 and titled
21 "Image Display Apparatus, And Method To Prevent Or Limit User Adjustment Of
22 Displayed Image Quality," a true and correct copy of which is attached hereto as
23 **Exhibit M**; and

24 U.S. Patent No. 6,549,243, issued April 15, 2003 and titled
25 "Digital Broadcast Receiver Unit," a true and correct copy of which is attached
26 hereto as **Exhibit N**; and

27 U.S. Patent No. 6,600,870, issued July 29, 2003 and titled
28 "Input-Output Circuit, Recording Apparatus And Reproduction Apparatus For

1 Digital Video Signal," a true and correct copy of which is attached hereto as
2 **Exhibit O**; and

3 U.S. Patent No. 6,693,966, issued February 17, 2004 and titled
4 "Transmitting And Recording Method, Reproducing Method, And Reproducing
5 Apparatus Of Information And Its Recording Medium," a true and correct copy of
6 which is attached hereto as **Exhibit P**; and

7 U.S. Patent No. 7,012,769, issued March 14, 2006 and titled
8 "Digital Information Recording/Reproducing Apparatus," a true and correct copy of
9 which is attached hereto as **Exhibit Q**; and

10 U.S. Patent No. 7,286,310, issued October 23, 2007 and titled
11 "Apparatus For Receiving Compressed Digital Information," a true and correct
12 copy of which is attached hereto as **Exhibit R**.

13 15. On information and belief, INPRO is a co-owner, licensee, or
14 licensing agent with respect to the PATENTS-IN-SUIT, or otherwise claims an
15 interest therein.

16 16. Defendants HITACHI and INPRO (collectively "Defendants")
17 have accused Plaintiffs of infringing the PATENTS-IN-SUIT by Plaintiffs'
18 manufacture and sale of televisions in the United States, and have threatened to
19 bring an action against Plaintiffs under 35 U.S.C. §§ 271(a), (b) and/or (c) alleging
20 that Plaintiffs have infringed the PATENTS-IN-SUIT by Plaintiffs' manufacture
21 and sale of television products.

22 17. Plaintiffs deny that they have infringed, or have contributed to
23 or actively induced infringement of any valid and enforceable claim of any of the
24 PATENTS-IN-SUIT through their manufacture and sale of television products.
25 Therefore, an actual and justiciable controversy exists between Plaintiffs and
26 Defendants regarding infringement, validity, and enforceability of the PATENTS-
27 IN-SUIT. This actual and justiciable controversy arises under federal patent law.

28 18. Plaintiffs seek a declaratory judgment that they have not

1 infringed, contributed to, or actively induced such infringement of the PATENTS-
2 IN-SUIT by any of their actions and/or a declaratory judgment that the PATENTS-
3 IN-SUIT are invalid and/or unenforceable.

4 19. A judicial declaration is necessary and appropriate at this time
5 pursuant to 28 U.S.C. § 2201, so that Plaintiffs may ascertain their rights and duties
6 with respect to the PATENTS-IN-SUIT.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, Plaintiffs pray for judgment in their favor as follows:

9 1. For a judicial declaration that the PATENTS-IN-SUIT, and each
10 of them, are not and have not been infringed by Plaintiffs, and that the same are
11 invalid and/or unenforceable;

12 2. That the Court determine that this is an extraordinary case and
13 award Plaintiffs their attorneys' fees and litigation expenses under 28 U.S.C. §
14 1927, 35 U.S.C. § 285, and any other applicable statute or rule; and

15 3. That the Court award Plaintiffs such other and further relief as
16 the Court deems just and proper.

17 Dated: April 14, 2010
18

19 MARK A. SAMUELS
20 BRIAN M. BERLINER
21 RYAN K. YAGURA
22 ALAN D. TSE
23 O'MELVENY & MYERS LLP

24 By: Mark A. Samuels/AT
25 Mark A. Samuels
26 Attorneys for Plaintiffs
27
28

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

TOP VICTORY ELECTRONICS,

Plaintiff,

v.

HITACHI LTD., et al.

Defendants.

No. C 10-01579 CRB

**ORDER GRANTING MOTION TO
DISMISS**

11/15/10

Plaintiff Top Victory Electronics, Ltd., TPV Electronics, Co., Ltd., Top Victory Electronics, Co., Ltd., and Envision Peripherals, Inc. (collectively, TPV), brought this action for declaratory judgment of non-infringement of seven patents related to digital televisions. Defendants Hitachi, Ltd. (Hitachi) and Inpro Licensing SARL (Inpro) move to dismiss for lack of standing, and therefore lack of subject matter jurisdiction. Inpro also moves to dismiss for lack of personal jurisdiction. Plaintiff moves to enjoin an action involving the same patents filed by subsidiaries of Hitachi in the Eastern District of Texas, and moves for leave to file a second amended complaint here.

While the parties dispute ownership of the patents at issue, Defendants effectively show that they do not have legal title to the patents, and did not have legal title at the time the action was filed. Therefore standing is not proper under the Patent Act. Further, Plaintiff does not meet its burden to establish standing under an equitable title holder theory.